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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052197
Party	Defendant Supercar Collectibles Limited
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Date	06/02/2011
Attachments	ReplyMotionStrike.pdf (8 pages)(933093 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of United States Trademark Registration No. 2,049,847

Terri Yenko Gould, Executor Petitioner, vs. General Marketing Capital, Inc./Supercar Collectables Limited Respondent.	) Cancellation No.:92052197

Respondent's Reply to Petitioner's Opposition to Respondent's Motion to Strike Testimonial Declarations Filed by Petitioner

Respondent hereby replies to Petitioner's Opposition to Petitioner's Opposition to Respondent's Motion to Strike Testimonial Declarations Filed by Petitioner, as follows:

A. Petitioner's Admission That Its Testimonial Declarations Were Filed Without Stipulation As Required by Trademark Rule 2.123(b) is in Itself Sufficient to Require Granting of Respondent's Motion to Strike

On page one of its opposition brief, Petitioner admits that there was no stipulation to allow filing of any testimony in declaration form. On that basis alone, Respondent's motion to strike must be granted. It would be unfair and highly prejudicial for the Board to consider Petitioner's testimonial declarations (and the accompanying exhibits) because those declaration and exhibits

were admittedly filed in knowing violation of the applicable Trademark Rules and without affording Respondent any opportunity to interpose objections or cross-examine the witnesses.

B. Petitioner Is Attempting to Pass Off Its Initial Disclosure Under Trademark Rule 2.120 as a Pretrial Disclosure Under Trademark Rule 2.121

Contrary to the assertions made in Petitioner's opposition paper, Respondent affirms that it did not receive any pretrial disclosure as required by 37 C.F.R. §2.121 and as ordered by the Board. In reality, the document that was served on Respondent on June 14, 2010 was an initial disclosure under 37 C.F.R. §2.120, not a pretrial disclosure under 37 C.F.R. §2.121. They are two different things. Petitioner's effort to pass off its initial disclosure under 37 C.F.R. §2.120 as a pretrial disclosure under 37 C.F.R. §2.121, compounded by the unfortunate personal accusations made on page 2 of its opposition brief, are shameful.

Initial disclosures under Trademark Rule 2.120 are designed to preliminarily identify persons known to have discoverable information. An initial disclosure under Trademark Rule 2.120 does not obligate the receiving party to take depositions from persons identified in the initial disclosure, nor does it substitute for timely expert or pretrial disclosures as required by the Trademark Rules. see, *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 U.S.P.Q.2d 1443 (TTAB 2009).

In this case, the initial disclosure that Petitioner provided pursuant to Trademark Rule 2.120 named only three of the four persons from whom testimonial declarations were proffered (Yenko-Gould, Clary and Quam). The initial disclosure also named a fourth person (Cunneen) from whom no testimonial declaration was proffered. The initial disclosure clearly indicates that Clary and Quam "may" offer expert testimony but only identified the content of such expert testimony in very

general terms. No follow-up expert disclosures were provided. Having no excuse for its failure to timely serve expert disclosures, Petitioner now contends that the expert opinions stated in the Clary and Quam declaration are not really expert opinions after all, but rather should be treated as "lay" opinions. The initial disclosure served under Trademark Rule 2.120 did not mention any such "lay" opinions. Nor did the initial disclosure mention that Mr. Bullwinkel, Petitioner's counsel of record, would attempt to serve double duty as both counsel for Petitioner and as a trial witness. In short, the initial disclosure failed to identify all witnesses and failed to state specific facts and opinion testimony that actually was ultimately contained in the last-minute declarations. Thus, the initial disclosure served pursuant to Trademark Rule 2.120 did not relieve Petitioner of its obligation to serve timely expert and pretrial disclosures and cannot be relied upon to avoid striking of the un-consented declaration testimony.

C. Allowing Respondent to Separately Depose Petitioner's Witnesses Is Not A Viable Remedy

Petitioner has not requested any re-opening of Petitioner's own testimony period. Rather, in its opposition brief, Petitioner proposes that the Board simply allow the un-consented testimonial declarations and exhibits to stand (even though Respondent had no opportunity to interpose objections or cross-examine the witnesses). Petitioner's motion also proposes that the Board extend Respondent's testimony period by 30 days, thereby placing on Respondent the burden to chase around the country attempting to take testimonial depositions from Petitioner's testimonial declarants at Respondent's expense. This scheme would not "obviate" Respondent's objections. Rather, it would only cause undue burden and prejudice to Respondent. Notably, three of the four testimonial

declarants are non-party witnesses and one of them is actually the counsel of record. Respondent would have to issue and personally serve subpoenas on those non-party witnesses in order to secure their deposition testimony. The testimonial declarants are at scattered locations around the country so considerable time and expense would be required. Moreover, because one of the testimonial declarants is Petitioner's counsel of record, a motion to disqualify counsel would have to be prepared, filed and granted before he could be compelled to testify even on non-privileged matters. Thus, for all of these reasons as well as others not specifically enumerated here, the proposal to extend Respondent's testimony period to allow Respondent to seek testimony form each of the testimonial declarants is unworkable, prejudicial and not acceptable to Respondent.

By submitting its highly disputed and objectionable testimony in declaration form on the last day of its testimony period, Petitioner sought to preclude Respondent from making objections on the record and/or cross-examining the witnesses. Furthermore, this maneuver has enabled Petitioner to avoid the expense of preparing expert and pretrial disclosures and taking live testimonial depositions at multiple locations. The Board cannot simply allow these un-consented testimonial declarations and accompanying exhibits to stand. These items must be stricken from the record.

Petitioner contends that Respondent was somehow obligated to take depositions from persons disclosed in Petitioner's initial disclosure document under Trademark Rule 2.120. This bizarre allegation and proposal is set forth at page 2 of Petitioner's brief states, as follows:

> *Given GMCI's failure to act on the documents and witnesses revealed in the September 2010 Pretrial Disclosure, the Estate agrees that it would be reasonable to extend GMCI's testimony period by an additional 30 days to allow it to take the*

depositions of the declarants and thus obviate any objections to their testimony. If GMCI is not willing to do that, then its objections should be overruled and the declarations admitted.

Respondent has not failed to act in any manner. After receiving Petitioner's initial disclosure under Trademark Rule 2.120, Respondent did take the discovery it deemed necessary and appropriate given the baseless nature of Petitioner's allegations. Respondent also performed extensive investigations of the Yenko estate and of the estate's prior abandonment of any trademark rights that it may once have owned. After months of silence and non-communication, Petitioner allowed its deadline for serving a pretrial disclosure under Trademark Rule 2.121 to come and go, without action. In view of these facts, Respondent reasonably expected that, at most, Petitioner would merely file a notice of reliance during its testimony period, which would have obviously failed to carry Petitioner's burden of proof. Petitioner sat idly by and allowed all but the last few days of its testimony period to pass without any communication or action whatsoever. Then, just a few days before the end of its testimony period, Petitioner's counsel sent an e mail from his vacation home in Paris requesting a stipulation to allow Petitioner to file testimony in declaration form, without any opportunity for objection or cross-examination by Respondent. Respondent duly and respectfully considered Petitioner's request and even tried to reach a reasonable compromise. However, when it became clear that Petitioner was simply playing games, Respondent expressly informed Petitioner that it declined to stipulate to any entry of trial testimony in affidavit or declaration form. Despite this fact, Petitioner proceeded with filing four (4) testimonial declarations and numerous document exhibits in willful disregard of the applicable Trademark Rules. Petitioner's suggestion that the Board should saddle Respondent with the burden and expense of separately taking testimonial depositions from the

persons who signed Petitioner's unauthorized testimonial declarations to "obviate any objections to their testimony" is unworkable, unfounded, ill conceived, contrary to the applicable Trademark Rules, unduly burdensome and prejudicial to Respondent.

Being in the position of a defendant, Respondent must be free to choose its trial witnesses and design its trial strategy based on testimony and other evidence that has been properly made of record during Petitioner's case in chief. It is impossible for Respondent to prepare a pretrial disclosure or design its trial strategy until it knows what, if any, testimony or evidence will remain in the record following decisions on Respondent's motion to strike and its dispositive motion for judgment. For precisely this reason, the Trademark Rules provide for an automatic stay of Respondent's pretrial disclosure and testimony period (as well as all subsequent deadlines). In this regard, Trademark Rule 2.127(d), provides as follows:

> ***37 CFR § 2.127(d)*** *When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

Thus, Respondent has not allowed any deadlines to pass and has indeed been diligent in its defense. Petitioner cannot blame Respondent for Petitioner's grossly negligent failure to serve expert and

pretrial disclosures or to conduct testimonial depositions in accordance with the Trademark Rules.

D. There Was No Consent, Implied or Otherwise, to Receive Service By E Mail

Petitioner failed to serve its testimonial declarations in accordance with Sections (a) and (b) of Trademark Rule 2.119. That's a fact. It is not unusual for opposing counsel in *inter partes* proceedings to send routine non-service communications back and forth by e mail. Doing so does not waive any requirement that documents which require service be served in compliance with Trademark Rule 2.119. There is no reasonable basis for Petitioner to contend that, merely because counsel had routinely sent non-service communications back and forth by e mail, such would constitute "implied" consent to receive service of trial testimony by e mail. This is especially true given the fact that all prior service of documents had been made by Petitioner by first class mail.

CONCLUSION

On the basis of the foregoing, Respondent respectfully requests that its motion to strike all testimonial declarations and exhibits filed by Petitioner be granted.

June 2, 2011

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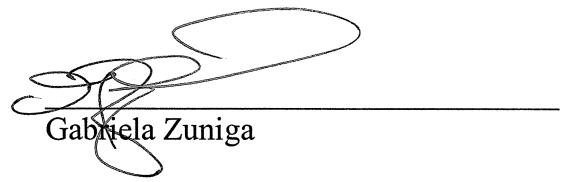
CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Respondent's Reply to Petitioner's Opposition to Respondent's Motion to Strike Testimonial Declarations Filed by Petitioner has been served on George E. Bullwinkel, Esq. by mailing said copy on June 2, 2011, via First Class Mail, postage prepaid to:

George E. Bullwinkel
Attorney at Law
425 Woodside Avenue
Hinsdale, IL 60521



Gabriela Zuniga